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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAOYUKI ORII, KAZUSUI HOSHINA, and
YOSHITAKA YOSHIDA

Appeal 2009-000577
Application 09/769,392,
Technology Center 2400

Decided:¹ August 11, 2009

Before, JOSEPH L. DIXON, JAY P. LUCAS, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appeal 2009-000577
Application 09/769,392

The Patent Examiner rejected claims 3, 5-6, 9, 11, 12, 15, 17-19, and 25. Claims 1-2, 4, 7-8, 10, 13-14, 16, and 20-24 have been canceled. The Appellants appeal the rejected claims under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method, an apparatus, and a computer readable medium for distributing information to pre-registered customer's portable terminals in and out of a specific area (Spec. 1).

The Illustrative Claim

Claim 9, an illustrative claim, reads as follows:

9. A method for distributing information on a shopping mall to portable terminals of customers, comprising:

registering in advance, using a terminal located in a store in the shopping mall, first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution;

registering in advance preference information regarding each customer;

Appeal 2009-000577
Application 09/769,392

perceiving a visit of the shopping mall by a customer;
and

distributing, when the distributing time comes, only the items regarding which the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting said shopping mall;

wherein the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting said shopping mall.

The Reference

The Examiner relies the following prior art as evidence in support of rejections:

Baranowski US 6,813,608 B1 Nov. 2, 2004

The Rejections

The following rejections are before us for review:

Claims 3, 5-6, 9, 11-12, 15, 17, 18 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Baranowski.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable Baranowski in view of Official Notice.

Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made

Appeal 2009-000577
Application 09/769,392

but chose not to make in the Briefs have not been considered and are deemed to be waived. *See 37 C.F.R. § 41.37(c)(1)(vii).*

II. ISSUE

Have Appellants shown that the Examiner erred in determining that Baranowski discloses “the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting said shopping mall,” as recited in independent claim 9?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burdens requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants have the opportunity on appeal to the Board of Appeals and Interferences (BPAI) to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Claim Interpretation

The claim construction analysis begins with the words of the claim.

See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk I, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003).

The *claims* measure the invention. *See SRI Int'l. v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation; and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364. The properly interpreted claim must then

be compared with the prior art.

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

IV. FINDINGS OF FACT

We rely on the following findings of fact (FFs) that are supported by a preponderance of the evidence:

1. Baranowski discloses distributing information via wireless communication system to a portable device of a customer in wide-area facilities such as shopping malls and amusement parks (col. 4 ll. 29-49).
2. Baranowski also discloses that the information distribution system can distribute the information to the portable device of the customer who is within the shopping mall to avoid long lines at point-of-sale equipment (POS) and to review advertisement such as the item for sale (col. 4 ll. 63-67 and col. 8 ll. 16-46).
3. Baranowski further discloses that after a customer who is not in the shopping mall has registered with the information distribution system, the system may provide the customer with personalized information, such as appropriate advertisements, similar products to the products purchased by the customer, and other messages such as e-mail messages. The information is distributed to the customer's computer (col. 14, ll. 1-52). Baranowski also discloses that the customer can make a schedule of reservation to an amusement park through a web host via internet. The web host may also provide personalized information to the registered customer such as review of information about the attractions of the amusement park and the weather forecast of the customer planned to visit (col. 15, ll. 3-31).

V. ANALYSIS

We find that the Examiner has set forth a detailed explanation of a prima facie case. Therefore, we look to Appellants' Brief to show error in the proffered prima facie case.

35 U.S.C. § 102(e)

With respect to claim 9, Appellants contend that Baranowski fails to disclose the second information (App. Br. 13), and in particular,

distributes the information *irrespective of where the customer is* ... The information is distributed based only on the customer's *reservation* and the web host does not pay any attention to the customer's current location at the time of distributing the information. For example, the customer may make reservations for the next visit while the customer is still currently visiting the wide-area facility.

(*Id.* at 13-14).

We disagree with Appellants. We begin our analysis with claim construction. We give the claims a broad, but reasonable interpretation. Here, we construe the argued limitation "the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting said shopping mall" in accordance with the ordinary and customary meaning that would have been attributed to the term by one of ordinary skill in the art at the time of the invention. We construe

the ordinary and customary meaning of “perceive” as “to take notice of” WEBSTER’S II New Riverside University Dictionary 872 (1984). We also note that there is no “the” or “said” before the term “portable terminals of customers.” Thus, the portable terminal which received the distributed second information is not necessarily the same as the portable terminal received the first information. The ordinary and customary meaning of a portable terminal can be construed as a cellular phone, a PDA, a laptop computer, or a desktop computer, etc. Therefore, the argued claimed limitation is being interpreted as the second information is distributed to a cellular phone, a PDA, a laptop computer, or a desktop computer of a customer while taking notice of the customer is not visiting the shopping mall.

We now review the merits of Appellants’ contentions. We find that Baranowski discloses that the customer can use a portable device for receiving sale information or information about the length of lines at a point of sale (POS) (the first information) when visiting a shopping mall (FF1 and FF2). We also find that Baranowski discloses transmitting appropriate advertisements or other messages according to the customer’s profile (the second information) to the customer when the customer is not visiting the shopping mall (FF3).

We find that Appellants’ above-noted contentions are not relevant to the argued limitations. The claimed invention requires that “the second information...is distributed to portable terminals of the customer not

perceived to be visiting said shopping mall,” and, in contrast, the example Appellants discussed describes that the customer can make a reservation while the customer is visiting the wide-area facility, which is not related to distributing the second information.

Appellants further contend that “there is not suggestion that when the customer is not perceived to be visiting the amusement park that information is sent to their portable terminal 100.” (Reply Br. 4). We disagree with Appellants’ contention.

On another point, we note that the Reply Brief is properly used to respond to points of argument raised by the Examiner in the Answer and not as a means for presenting new arguments. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). While having fully considered Appellants’ responses in the Reply Brief, we decline to address any new arguments not originally presented in the principal Brief. With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Here, we find that Appellants’ contention regarding the information is sent to the portable terminal is firstly presented in the Reply Brief. We, nevertheless, find that Baranowski expressly teaches that the web host may deliver any appropriate advertising, reviews of the attractions, or other

personalized information (the second information) to the customer’s computer with that customer’s profile (FF3) under our claim construction.

Therefore, we find Appellants have not shown that the Examiner erred in determining that Baranowski discloses “the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting said shopping mall,” as recited in representative claim 9. Independent claims 3, 15, and 25 are directed to corresponding system and computer readable medium claims which contain similar limitations as in independent claim 9, and Appellants present similar arguments thereto. Therefore, we do not find these arguments persuasive of error in the Examiner’s initial showing of anticipation. Accordingly, we sustain the Examiner’s anticipation rejection of independent claim 3, 9, 15, and 25.

We also sustain the Examiner’s anticipation rejection of dependent claims 5-6, 11-12, and 17-18, which have not been separately argued. 37 C.F.R. § 41.37(c)(1)(vii) (2007). *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

35 U.S.C. § 103(a)

With respect to dependent claim 19, Appellants further contend that 1) “one would not have been motivated to modify Baranowski to include the missing features related to the second information discussed above; and 2) “no teaching or suggestion for one of ordinary skill in the art to supplement

the previously discussed deficiencies of Baranowski based on the disclosure of Baranowski.” (App. Br. 16).

The Examiner takes “Official Notice” and maintains that a program divided into a plurality of segments that are recorded on the plurality of storage media was well known in the art (Ans. 7 and 12). The Examiner also provides the motivation to combine the “Official Notice” and Baranowski (*Id.* at 7).

We agree with the Examiner’s line of reasoning. Appellants did not challenge the Examiner’s Official Notice that the argued limitations are well known, nor did Appellants argue substantively why one skilled in the art would not have been motivated to modify Baranowski. In our view, the combination of familiar elements, for example, the scheme of distributing information to a portable device of a customer in wide-area facilities such as shopping malls with well known segmented organization in the storage media, is nothing more than a “predictable use of prior art elements according to their established functions”².

In addition, Appellants rely upon the arguments for patentability advanced with respect to independent claim 9. Since we found Appellants’ arguments unpersuasive with respect to independent claim 9, we similarly find Appellants’ arguments unpersuasive of error in the Examiner’s initial showing of obviousness with respect to dependent claim 19.

Accordingly, we sustain the Examiner’s rejection of claim 19 as

² See *KSR*, 550 U.S. at 417

Appeal 2009-000577
Application 09/769,392

being unpatentable over Baranowski.

VI. CONCLUSION

We conclude that Appellants have not shown the Examiner erred in determining that Baranowski discloses “the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting said shopping mall,” as recited in independent claim 9.

VII. ORDER

We affirm the rejection of claims 3, 5-6, 9, 11-12, 15, 17-18, and 25 under 35 U.S.C. § 102(e).

We also affirm the rejection of claim 19 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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